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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,032	10/03/2000	Mark B. Lester	1671-0099	5677

7590 12/15/2008  
Maginot, Moore & Beck LLP  
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EXAMINER
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PRONE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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12/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/678,032  
Filing Date: October 03, 2000  
Appellant(s): LESTER ET AL.

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Paul J. Maginot  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/1/08 appealing from the Office  
action mailed 1/29/08.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,123,806	Amstutz	11-1978
5,782,928	Ries	7-1998
5,879,404	Bateman	3-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-44 are rejected under 35 U.S.C. 103 as being unpatentable over USPN 5,879,404 Bateman et al in view of USPN 5,782,928 Ries et al. and further in view of USPN 4,123,806 Amstutz et al.

Bateman discloses an acetabular cup comprising an apex portion 8, a liner 7, and an upper rim, and an outer-surface 82 having a hemispherical shape

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that is aligned with the surface of an imaginary hemisphere from the bottom of the apex portion to the second plane shown best in figure 4. However Bateman does not disclose that the acetabular cup is about 1 millimeter less than a complete hemisphere or a method for inserting the device.

Ries discloses a method for securing an acetabular cup comprising an apex portion 83, an upper rim, and an outer-surface 82 to an acetabulum. The securing steps include reaming a hemispherically shaped cavity into said acetabulum that is smaller than the largest diameter 68 of the cup in order to form an interference fit.

Amstutz discloses an acetabular cup 18 having an apex and upper rim 58 that is configured to be press-fit into a cavity prepared in the acetabulum. Amstutz discloses a cup 18 that can be precisely hemispherical or 1 or 2 millimeters less than a hemisphere. This shape would then render a distance (D) between the "great circle" and the lower plane of the imaginary hemisphere within the applicants claimed range (6: 5-8). Amstutz further discloses a bearing insert 16 configured to be received with the acetabular cup 18 and is further configured to mate with head portion of the femur 12. The cup 18 and its upper rim 58 lie flush with the surface of the cavity of the acetabulum (7:36-42). The device of Amstutz is in the same field of endeavor teaches the less than hemispherical shape for the purpose of avoiding impingement of the cup.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the less than hemispherical shape taught by Amstutz with the device of Bateman and to insert the implant with the

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method taught by Ries in order to provide a secure fit and to prevent impingement of the cup.

#### **(10) Response to Argument**

The applicant argues that Ries does not teach press fitting a sub-hemispherical shaped cup in a hemispherical cavity. The examiner is not convinced by this argument because the rejection is not based solely on the Ries rejection. The rejection uses Bateman to teach a basic structure, which is modified by Amstutz to included the modified shape. The combination of Bateman and Amstutz fails to disclose the method for implantation so the rejection relies on Ries to teach the press fit insertion method. The rejection does not use Ries for structure nor would it be bound by any structure disclosed by Ries. Ries is simply used to teach that an acetabular cup may be implanted using an oversized press fit connection. The applicant has failed to provide evidence of any deficiency in the combination or teaching away from such combination, therefore the rejection remains valid.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Christopher D Prone/

Examiner, Art Unit 3738

Conferees:

/Corrine M McDermott/

Supervisory Patent Examiner, Art Unit 3738

/Thomas Barrett/

TQAS TC3700